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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,985	01/19/2001	Michael A. Sharp	8247-82809-01	1204

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KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER	
MITTAL, KRISHAN K	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
11/18/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tanya.harding@klarquist.com
docketing@klarquist.com

Office Action Summary	Application No.	Applicant(s)	
	09/765,985	SHARP, MICHAEL A.	
	Examiner	Art Unit	
	Kris Mittal	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *BPAI Decision of May 14, 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Board of Patent Appeals and Interferences Decision dated May 14, 2010. The Board has affirmed the rejection of Claims 14-24 denominating the affirmed rejection of Claims 14-34 as new grounds of rejection. Therefore, Claims 14-34 are withdrawn from consideration. Claims 1-13 were previously canceled. The Board has reversed the rejection of Claims 35-37. Therefore, Claims 35-37 are considered below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Willbanks (5,703,995).

As to claim 35, Willbanks teaches in col. 7, lines 44 – 65,

creating a combined audio file from two audio files (*the audio controller may "mix" or concatenate multiple audio files)*

wherein at least one of the two audio files produces an advertising message (*an advertising message, as interpeted by the examiner, could be any message combined*

with another message, for example a song title, singer, introduction, or words of the song could all broadly considered as an ***advertising message.*** *Also, the fact that one of the files is an advertising message does not change the method step of combining/mixing one audio file with another audio file.*

making the combined audio file accessible for download by multiple users (*The audio files are provided within the audio storage device 148, or may be downloaded to the audio controller, once the mixed audio file is stored it is accessible to multiple users)*

transmitting the combined file to a user computer for transfer to an external multimedia player (*element 155, edit deck, Fig 3. is use to transmit to play systems)*

As to claim 36 and 37, any time the combined video and audio file is played it is transmitted and played by the receiving device.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

. 3. **Claims 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsutsui et al., U.S. Patent No. 6,963,860 (hereinafter referred to as Tsutsui).**

As to claim 35, Tsutsui discloses an advertising method that comprises:

creating a combined audio file from two audio files (Fig. 31, block 212: signal transform and combining section), wherein at least one of the two audio files produces an advertising message (Fig. 31: music + advertising signal; col. 24, lines 34-40: combines the advertising voice signal input and the pure music signal; and outputs the resultant signal) when played;

making the combined audio file accessible for download (col. 28, lines 6-9: it is made possible for the user to reproduce the music signal any number of times at no charge; lines 31-33: advertising voice signal is adopted as the signal superimposed on the music) by multiple users via a computer network (col. 28, line 66 to col. 29, line 3: as distribution media for distributing a computer program to the user, communication media such as network can be used); and

transmitting the combined audio file (col. 24, lines 3-6: receives input of the advertising voice signal plus the encrypted pure music signal through the transmission medium) to a user computer where the entire combined audio file is saved (col. 28, lines 6-9: it is made possible for the user to reproduce the music signal of the third code string (corresponding to the first code string - *music plus advertising* - any number of times at no charge) for later playback (col. 5, lines 12-15: the listener can playback the music signal with the commentary voice) or transfer to an external multimedia player.

As to claim 36, Tsutsui discloses the method of claim 35 (as rejected above) and further discloses, further comprising transmitting (col. 23, line 64 to col. 24, line 2: combining section; outputs the result to the transmission medium) the combined audio file to each of multiple users to store (col. 24, line 51: for recording the result – *combined audio signals*).

As to claim 37, Tsutsui discloses the method of claim 35 (as rejected above) and further discloses, wherein the advertising message is played each time a user plays the combined audio file (col. 28, lines 37-43: person who buys a comparatively inexpensive reproducer that can decode only the first code string – *music plus advertising combined*; lines 54-56: it is made possible for the user to reliably use information at no charge) saved on the user computer.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 35-37 are rejected under U.S.C. 103 (a) as being unpatentable over Tsutsui et al., U.S. Patent No. 6,963,860 (hereinafter referred to as Tsutsui).**

As to claim 35, Tsutsui discloses an advertising method that comprises:

creating a combined audio file from two audio files (Fig. 31, block 212: signal transform and combining section), wherein at least one of the two audio files produces an advertising message when played (Fig. 31: music + advertising signal; col. 24, lines 34-40: combines the advertising voice signal input and the pure music signal; and outputs the resultant signal); and

making the combined audio file accessible for download (col. 28, lines 6-9: it is made possible for the user to reproduce the music signal any number of times at no charge; lines 31-33: advertising voice signal is adopted as the signal superimposed on the music) by multiple users via a computer network (col. 28, line 66 to col. 29, line 3: as distribution media for distributing a computer program to the user, communication media such as network can be used).

Tsutsui does not explicitly disclose where the entire combined audio file is saved for later playback or transfer to an external media player.

However, Tsutsui discloses making available to users a combined file with music and advertising voice at relatively low cost while providing ability to listen to pure music *without advertising voice* if user would purchase an expensive reproducer (col. 28, lines 37-56: an expensive reproducer can decode both the first string and the second string; person who buys a comparatively inexpensive reproducer that can decode only the first code string – *music plus advertising combined*; lines 54-56: it is made possible for the user to reliably use information at no charge – *save for later playback*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Tsutsui to explicitly provide for transmitting the combined audio file to a user computer where the entire combined audio file could be saved for later playback or transfer to an external multi-media player. One would have been motivated to save the combined audio file in order to allow the user to listen to the saved file at a more appropriate time, e.g. when the user is not involved with other activities..

As to claim 36, Tsutsui discloses the method of claim 35 (as rejected above) and further discloses, further comprising transmitting the combined audio file (col. 23, line 64 to col. 24, line 2: combining section; outputs the result to the transmission medium) to each of multiple users to store (col. 28, lines 54-56: it is made possible for the user to reliably use information at no charge)

As to claim 37, Tsutsui discloses the method of claim 35 (as rejected above) and further discloses, wherein the advertising message is played each time a user plays the combined audio file (col. 28, lines 37-43: person who buys a comparatively inexpensive reproducer that can decode only the first code string – *music plus advertising combined)*

Tsutsui does not explicitly disclose saving audio files in user computer. However, Tsutsui discloses users reproducing the information (col. 28, lines 6-9: it is made possible for the user to reproduce the music signal any number of times; lines 54-56: it

is made possible for the user to reliably use information at no charge). It is obvious that the audio file is saved by user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Tsutsui to explicitly provide for user saving the combined audio file on his/her computer so that the advertising message will be played each time the user plays the combine audio file, motivation being increased advertising exposure while allowing user to enjoy music at a time of his/her choosing.

Response to Reversal by BPAI

6. Examiner has reviewed the Decision of the Board of Appeals and Interferences which reverses the rejection of **claims 35-37.**

a. In reversing the rejection of **Claims 35-37**, the BPAI Decision states:

"Independent claim 35 (on which claims 36 and 37 depend) adds a step of saving a transmitted downloadable combined audio file to a user computer. The issue here is whether Wolfe shows or would have led one of ordinary skill in the art to save a download to a user's computer. The Examiner concedes that Wolfe does not expressly disclose locally storing its streamed audio file. Answer 8. However, according

to the Examiner, Wolfe's discussion of a security measure for preventing copying implies that if the security measure is not adopted, the audio file can be copied, an act which requires the file to first be saved. Answer 8. The difficulty with this argument is that copying a file does not necessarily require a file to first be saved on a computer. The Examiner also argues that "Official Notice is taken that it was old and well known at the time of the invention that incoming data file can be locally stored [e.g.,] on the receiving device's hard drive " Answer 8. However, the Appellant extensively argues that the type of streaming Wolfe conducts is incapable of being locally stored. App. Br. 21-22.3 Appellant has provided adequate information and argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's Notice that locally storing a streamed audio file is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728 (CCPA 1971). Under this circumstance, it was incumbent on the Examiner to support the Official Notice with evidence. Since that was not done, the record as it now stands does not establish a prima facie case of obviousness for the claimed subject matter".

b. In view of the Decision, the Examiner has replaced the previous rejection with a reference that discloses the invention of claims 35-37.

Tsutsui discloses creating combined audio files from two audio files containing music and advertising voice, transmitting the files to users, where the entire combined file can be played any number of times, as discussed in the rejection above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Walinski, U.S. Patent No. 6,381,314 describes downloading audio streams
- Wolfe et al., U.S. Patent No. 5,932,901 describes music on demand from the Internet
- Heckel, U.S. Patent No. 6,036,601 describes advertising over computer network in virtual environment of games
- Weisberg et al., U.S. Patent No. 6,351,736 describes displaying advertisements when music is being played

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kris Mittal whose telephone number is (571)270-5492. The examiner can normally be reached on Monday-Thursday 7.30 AM-5.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KM
10/12/10

REOPENING OF PROSECUTION RECOMMENDED

Supervisory Patent Examiner, Art Unit 3688
/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3688

REOPENING OF PROSECUTION AUTHORIZED

Wynn W. Coggins
Director TC 3600